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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,698	10/17/2000	Guy Nathan	871-95	1505
23117	7590	02/18/2004	EXAMINER	
NIXON & VANDERHYE, PC 1100 N GLEBE ROAD 8TH FLOOR ARLINGTON, VA 22201-4714			JONES, SCOTT E	
			ART UNIT	PAPER NUMBER
			3713	20

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/688,698

Applicant(s)

NATHAN ET AL.

Examiner

Scott E. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment and request for continued examination filed on November 28, 2003 in which applicant adds new claim 19 and responds to the claim rejections.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on November 28, 2003 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12, 15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (U.S. 5,848,398) in view of Johnny Rockets Name That Tune.

Martin et al. discloses a method and apparatus for managing a plurality of computer jukeboxes at different locations from a remote central station. The remote central station maintains a host computer having a master library of songs stored in a bulk storage unit and each "jukebox" maintains a subset song library of the master library of songs. Each jukebox is updated with new

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songs and menus by simply downloading the data via a transmission link. Furthermore, in one embodiment, the computer jukebox is associated with an electronic game. Martin et al. additionally discloses:

Regarding Claims 12 and 19:

- a remote server (central management system (11)) and at least one terminal (jukebox #1..jukebox #N (13)) operable to communicate with the server over a communications network, wherein the terminal (jukebox) includes an audio system (127, 129, and 131) for playing in connection with a game (electronic game) at least a portion of a musical recording (Abstract, Figures 1, 4A, 4B, 5, Column 1, line 66-Column 2, line 51, and Column 3, line 15-Column 4, line 40, and Column 9, lines 38-42);
- the terminal is a jukebox system that includes a storage device (93) that stores a library of musical recordings (91) that can be played in full on the terminal for a fee (Figure 5), and further wherein the library of musical recordings can be updated with additional musical recordings through communication with the server, thereby defining a customized library of musical recordings on the jukebox system (Abstract, Figure 1, 4, 5, Column 1, line 66-Column 2, line 51, Column 3, line 15-Column 4, line 40, Column 4, lines 58-63, Column 5, lines 40-57, Column 6, lines 8-18, Column 6, lines 45-52, and Column 7, lines 39-57).

Martin et al. seems to lack explicitly disclosing:

Regarding Claims 12 and 19:

- a display that displays information in the form of a question and suggests multiple choice answers to the question, wherein the question relates to the portion of musical

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recording that has been played, a user interface that enables a user to select an answer from the displayed multiple choice answers, and a scorer for recording the answer selected by the user and determining if the answer corresponds to a correct answer; and

- further wherein the jukebox system is operable to dynamically select the musical recording for the game from the customized library of musical recordings and to dynamically generate the question for the game based on the contents of the customized library of musical recordings stored on the jukebox system.

Regarding Claim 15:

- the terminal sends information to the server regarding how the user performed during the game.

Johnny Rockets Name That Tune teaches of a Name that Tune game that is played over a network, such as, the Internet. Johnny Rockets Name That Tune and Martin et al. are analogous art because each are computerized game systems that are associated with music played on jukeboxes. Johnny Rockets Name That Tune, however, seems to lack explicitly disclosing playing a song for a fee.

Johnny Rockets Name That Tune teaches:

Regarding Claims 12 and 19:

- a display that displays information in the form of a question and suggests multiple choice answers to the question (questions 1-5), wherein the question relates to the portion of musical recording that has been played, a user interface (Web page and player personal computer mouse and keyboard) that enables a user to select an answer from the displayed multiple choice answers, and a scorer for recording the

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answer selected by the user and determining if the answer corresponds to a correct answer (How Did I Do?); and

- further wherein the jukebox system is operable to dynamically select the musical recording for the game from the customized library of musical recordings and to dynamically generate the question for the game based on the contents of the customized library of musical recordings stored on the jukebox system.

Regarding Claims 15 and 19:

- the terminal sends information to the server regarding how the user performed during the game (How Did I Do?).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Johnny Rockets Name That Tune game in Martin et al. One would be motivated to combine Martin et al. with Johnny Rockets Name That Tune because the Johnny Rockets Name That Tune game is entertaining and would provide an additional source of profit for Martin's computer jukebox system when in the game mode.

5. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnny Rockets Name That Tune in view of Tom & Liz's Name That Tune.

Johnny Rockets Name That Tune teaches that as discussed above regarding Claims 12, 15, and 19. Johnny Rockets Name That Tune seems to lack explicitly disclosing a ranking system to rank player's performance.

Tom & Liz's Name That Tune, like Johnny Rockets Name That Tune is a computer/network-based name that tune game. Tom & Liz's Name That Tune shows:

Regarding Claim 16:

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- the server collects game performance information for a plurality of different users and ranks the users according to their performance (pp. 4 and 5 of 10).

Regarding Claim 17:

- the server is operable to send user-ranking information to the terminal, and the terminal is operable to display ranking information.

Regarding Claim 18:

- the system includes a plurality of said terminals (each player's personal computer having an Internet connection) at different locations (players live in a plurality of states), each of the terminals being operable to communicate with the server, and further wherein the server is operable to collect performance information on users who play the game at any of the terminals to send user ranking information to each of the terminals.

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate the player performance ranking system of Tom & Liz's Name That Tune game in Johnny Rocket's Name That Tune game. Providing a display of player rankings for games or game tournaments is notoriously well known to one of ordinary skill in the gaming art. Doing so motivates a game player to perform well and enables players to size up the competition.

Response to Arguments

6. Applicant's arguments filed November 28, 2003 have been fully considered but they are not persuasive.

7. Applicants do not agree with the rejection to claims 12 and 15 under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (U.S. 5,848,398) in view of Johnny Rockets Name That Tune. Applicant alleges there is no suggestion to combine Martin and Johnny Rockets Name That Tune. Furthermore, applicant alleges, "Contrary to the unfounded allegation set forth in the Office Action,

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there is no teaching or suggestion in Martin of the computer jukebox being operable as a game.”

However, the examiner respectfully disagrees. Martin clearly discloses that the system can be used as an electronic game as cited in Column, 2, lines 49-51 and Column 9, lines 38-42. Furthermore, it would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Johnny Rockets Name That Tune game, in lieu of another game, in Martin et al. One would be motivated to combine Martin et al. with Johnny Rockets Name That Tune because the Johnny Rockets Name That Tune game is entertaining and would provide an additional source of profit for Martin's computer jukebox system when in the game mode.

8. Applicant's disagree with the rejection to claims 16-18 under 35 U.S.C. 103(a) as being unpatentable over Johnny Rockets Name That Tune in view of Tom & Liz's Name That Tune. Applicant's allege Tom & Liz fail to overcome the deficiencies of Johnny Rockets Name That Tune as noted above and as discussed in the prior response. The examiner respectfully disagrees. Please see the response in item No. 7 above. Furthermore, regarding claims 16-18, applicants' acquiesced to the rejection applied to the claims under 35 U.S.C. 103(a) as being unpatentable over Johnny Rockets Name That Tune in view of Tom & Liz's Name That Tune by virtue of not addressing the rejection in Paper No. 13, dated September 13, 2002 as previously noted in Paper No. 14, mailed November 29, 2002. Therefore, the rejection to claims 16-18 under 35 U.S.C. 103(a) as being unpatentable over Johnny Rockets Name That Tune in view of Tom & Liz's Name That Tune renders the claimed invention obvious.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Mastronardi '951 and Nathan et al. '204 disclose network based Jukebox systems.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott E. Jones
Examiner
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